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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER
WEST, JEFFREY R

ART UNIT	PAPER NUMBER
2857	

DATE MAILED: 09/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *12 July 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-40* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-40* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *05 December 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

    1.☐ Certified copies of the priority documents have been received.

    2.☐ Certified copies of the priority documents have been received in Application No. _____.

    3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
    application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8 and 37 contain the trademark/trade name JAVA. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a programming language and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1-4, 7-9, 14-33, and 36-40 are rejected under 35 U.S.C. 103(a) as

being unpatentable over U.S. Patent No. 6,385,552 to Snyder in view of U.S.

Patent No. 6,308,326 to Murphy et al.

Snyder discloses a method for collecting and controlling test

measurements using programmed instructions comprising determining the

variation to a measurement process (i.e. determining a test of interest to

perform and relating the test of interest to test variables and independent

variables and varying the test variables during the process) (column 3, lines

50-58 and column 16, lines 5-14), providing a process modification software

module including a user defined function for causing the variation and

associating the user-defined function with the variation function wherein

control is passed to the user-defined function when a variation point in the

computer program is reached (i.e. a menu subroutine is executed when a

variation point of the program is reached and, upon the selection of a user-

defined function/procedure from the menu, control is passed from the menu

subroutine to the selected procedure/passed into the measurement process)

(column 26, lines 33-67).

Snyder discloses that the function calls used in the process are operable

to invoke interfaces and to pass parameters to the variation functions

including keywords (column 26, lines 62-67) or measurement data (column

29, lines 49-53) as well as operable to receive/retrieve parameters back from

the variation function including control parameters indicative of the selected

instructions provided (column 26, lines 49-52). Snyder also discloses an

interface servicing element (i.e. menu interpreter) that services an interface

recognized by the measurement process (i.e. the menu interpreter is called

upon when the variation point is reached in order to execute the menu

subroutine for obtaining the user defined function) (column 23, line 57 to

column 24, line 3), wherein the interface is selected by the user (column 26,

lines 16-44) and operates in accordance with a predetermined binary protocol

(column 27, lines 20-24).

Snyder also discloses that the measurement process is first initiated

through system initiation using a first plurality of instructions followed by

variation using the user-defined menu functions with a second plurality of

instructions (column 22, lines 28-33), including a plurality of function calls

(column 25, line 62+), and, upon a user-defined selection, return the control to

an internal measurement process procedure (column 18, lines 56-62).

With respect to claim 8, Snyder also discloses providing the process

modification software modules as Active X (i.e. Component Object Module)

Dynamically Linked Libraries (column 20, lines 12-23).

With respect to claims 14-18, Snyder discloses that the variation in the

measurement process modifies either string or numeric data (column 14, lines

10-11) as well as provides a menu of selectable alternatives for user-

modification of control parameters, test device configuration, and device input

signals (column 3, lines 53-55, column 5, lines 3-6 and 50-59, and column 17,

lines 31-38) and since the parameters are used for control of the device

inputs and configuration, these parameters are considered to be digital control codes.

With respect to claims 19 and 20, Snyder also discloses that in addition to the aforementioned user-defined function called by the variation point that calls to the menu subroutine, further user-defined security and test set functions are also called to when associated variation points for the security and test set subroutines are reached (column 23, lines 57-67).

With respect to claim 9, Snyder also discloses executing both the measurement process and the process modification in the same computer space (i.e. computer "200") (column 3, lines 49-58 and Figure 1).

With respect to claim 39, since the function calls disclosed by Snyder are in the instruction code, operable to control the measurement process at a variation point in the code, and allows corresponding user input to modify the measurement process, it is considered inherent that the designer of the instruction program has anticipated that the user may want to interact with or modify the measurement process because the designer of the code would have eliminated the possibility of user intervention and would not have provided user prompts if such interaction was not desired.

With respect to claim 40, Snyder discloses a computer readable medium in accordance with the process (column 3, lines 51-53) and a physical interface operable to supply signals to a device under test and receive signals from a device under test (column 3, lines 53-58).

As noted above, the invention of Snyder teaches many of the features of the claimed invention and while Snyder does teach providing a user-defined function of a software module for variation of a measurement process, Snyder does not specify that the process modification software module be user-generated.

Murphy teaches run-time modules for dynamically adjusting computer operation including a computer-implemented method for allowing a user to modify a computer process (column 2, lines 26-29 and column 4, lines 40-54) including determining variation points in the process (column 2, lines 35-44), providing a user-generated process modification software module comprising a user-defined function for causing the variation (column 2, lines 45-51 and column 9, line 16 to column 10, line 25) associating and passing control to the user-defined function and user-generated process modification software module when the variation point in the computer program is reached (column 7, lines 16-28), and returning control to the process upon execution of the process modification software module (column 7, lines 29-51).

It would have been obvious to one having ordinary skill in the art to modify the invention of Snyder to specify that the process modification software module be user-generated, as taught by Murphy, because, as suggested by Murphy, the combination would have given the user increased control of the measurement process by adapting the software for the specific needs of the user while not introducing any problems related to version control, parallel development, or problem replication thereby increasing the functionality of the

software and reducing the cost and complexity of software adaptation (column 2, lines 45-56).

5. Claim 5, 6, 10-13, 34, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Snyder in view Murphy and further in view of U.S. Patent Application Publication No. 2002/0026514 to Ellis et al.

As noted above, the invention of Snyder and Murphy teaches many of the features of the claimed invention including an automatic testing system comprising a user interface to allow the user to control the testing a device wherein the interface operates in accordance with a predetermined binary protocol. Snyder does not teach, however, specifying that the predetermined protocol be a Simple Object Access Protocol or Common Object Request Broker Architecture or that the measurement process and the modification software are located in separate remote computers that communicate over a network.

Ellis teaches automated tool management in a multi-protocol environment comprising measuring/polling software located on a server computer system with corresponding processor and memory (0025, lines 1-13) and user process control software (0007, lines 11-16) located on a separate remote computer (0023, lines 13-18), wherein the process control software and the monitoring/polling software communicate over a network using predetermined protocol including Common Object Request Broker Architecture and Simple Object Access Protocol (0007, lines 1-11).

It would have been obvious to one having ordinary skill in the art to modify

the invention of Snyder and Murphy to include specifying that the

predetermined protocol be a Simple Object Access Protocol or a Common

Object Request Broker Architecture, and that the measurement process and

the modification software are located in separate remote computers that

communicate over a network, as taught by Ellis, because, the combination

would have eliminated the burden of requiring the user to be at the location of

the device being tested through the measurement process, allowed the

process to be monitored by experts located distant from the device under test,

and, as suggested by Ellis, provided a method for correcting any determined

problems through remote diagnostics and repair (0008, lines 12-14) as well

as allowed the device to be monitored by a team of users rather than just one

user at the device itself (0023, lines 1-4).

Response to Arguments

6. Applicant's arguments with respect to claims 1-40 have been considered

but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to

Applicant's disclosure.

U.S. Patent No. 6,427,228 to Wigger teaches a method for combining a

meta file and java source code to dynamically create java classes and

javabeans thereby creating user-generated software modules.

U.S. Patent No. 5,418,941 to Peters teaches a method and apparatus for

a dynamic application test facility.

U.S. Patent No. 6,202,043 to Devoino et al. teaches a computer based

system for imaging and analyzing a process system and indicating values of

specific design changes.

U.S. Patent No. 4,947,315 to Sokolow et al. teaches a system for

controlling an instrument using a levels data structure and concurrently

running compiler task and operator task.

8.   Any inquiry concerning this communication or earlier communications

from the examiner should be directed to Jeffrey R. West whose telephone

number is (703)308-1309. The examiner can normally be reached on

Monday through Friday, 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, Marc S. Hoff can be reached on (703)308-1677. The

fax phone number for the organization where this application or proceeding is

assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application

or proceeding should be directed to the receptionist whose telephone number

is (703)308-0956.

jrw
August 30, 2004

MARC S. HOFF
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2800